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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,455	09/29/2003	Mitsuru Kato	242963US0CONT	6647

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,455

Applicant(s)

KATO ET AL.

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 24-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/059,410.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/29 & 10/20/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 24, 25, 28-30, 35-41, 44, 45 and 48, drawn to a separable fastener coated with a composition comprising an aqueous dispersion of a polyurethane derived from a macromolecular polyol, a polyisocyanate a chain extending agent and 2,2-dimethylolbutanoic acid and, optionally, an aqueous dispersion of an acrylic resin, classified in class 24, subclass 442.
- II. Claims 26, 27 and 34, drawn to the separable fastener of Group I wherein the composition further comprises a curing agent, classified in class 24, subclass 448.
- III. Claims 31-33, drawn to the separable fastener of Group I wherein the aqueous polyurethane dispersion further comprises a plasticizing compound, classified in class 24, subclass 449.
- IV. Claims 42 and 43, drawn to the separable fastener of Group I wherein the aqueous polyurethane dispersion is further derived from a tertiary amine, classified in class 24, subclass 451.
- V. Claims 46 and 47, drawn to a method of manufacturing a separable fastener, classified in class 427, subclass 385.5.

The inventions are distinct from each other because:

2. Inventions I and (II or III or IV) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a molding formulation and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. The compositions of Groups II, III and IV form structurally distinct dried products based on the addition presence of the curing agent of Group II, the plasticizer of Group III, and the tertiary amine of Group IV.

4. Inventions V and (I or II or III or IV) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown:
(1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process (MPEP § 806.05(f)). In the instant case, the separable fastener can be coated with a materially different composition containing a polyester or polyamide.

Restriction for examination purposes as indicated is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- a) The macromolecular polyols of the aqueous polyurethane dispersion. The polytetramethylene glycol (PTG1000 as identified in Table 1 on page 19 of the specification) of Reference Example 1 on page 22, lines 4-19 was elected in parent application no. 10/059,410 in the non-Final rejection mailed June 4, 2003 on page 6.
- b) The chain extending agents of the aqueous polyurethane dispersion. The piperazine hexahydrate (PIP) of Reference Example 1 was elected in the parent application.
- c) The coating compositions with or without the aqueous acrylic resin dispersions, wherein if its presence is elected, a particular species thereof is identified such as the acrylic resin obtained from allylmethacrylate, hexanediol diacrylate, methyl methacrylate and methacrylic acid shown in Reference Example 11 on page 22, lines 4-19. The absence of the aqueous acrylic resin was elected in the parent application.

d) Contingent upon the election of Group II, items a), b) and c) hereinabove and the curing agents such as the polyepoxide CR-5L employed in Example 1 on page 25, lines 9-10.

e) Contingent upon the election of Group III, items a), b) and c) hereinabove and the plasticizing compounds such as the ethylene dibromide-4,4'-isopropylidene bis(2,6-dibromophenol) condensate of claim 32.

f) Contingent upon the election of Group IV, items a), b) and c) hereinabove and the tertiary amines such as the diethylaminoethanol (DEAE) of Reference Example 1.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species ***within each of items a), b) and c), and d), e) or f)*** if appropriate, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 24-48 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Surinder Sachar on November 1, 2005 to request an oral election to the above restriction and election of species requirement, but did not result in elections being made. The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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5. The specification on page 1 referring to the preliminary amendment filed September 29, 2003 should update the status of parent application no. 10/059,410 from "pending" to "abandoned."
6. Higashinaka et al. Patent No. 5,231,738 (Figures 1(a) and 1(b) and col. 8, lines 1-12) discloses an adhesive layer 5 for a separable fastener.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712